

**REMARKS/ARGUMENTS**

In the Office Action, the Examiner noted that claims 1-3 and 5-22 are pending in the application and that claims 1-3 and 5-22 are rejected. By this response, claims 1, 10, 16 and 21-22 have been amended. Thus, claims 1-3 and 5-22 remain pending in this application.

**Claim Objections**

Claims 1 and 21 are objected to because of the following information: "an image forming device" is recited twice in these claims.

Claims 1 and 21 have been amended in order to clarify the claimed subject matter and overcome the objection. Hence, Applicants asserts that claims 1 and 21 overcome the present objection.

**Rejection Under 35 U.S.C. §112, first paragraph**

Claims 10-16 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement, as the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Amendment has been made to independent claim 10 (as well as dependent claims 11-15) in order to clarify the claimed subject matter. Furthermore, Applicants traverse the Examiner's rejection under 35 U.S.C. §112, first paragraph. Applicants assert that the written description requirement has been met by claims 10-15.

More particularly, it is well understood that the written description requirement places in possession of the public that which the Applicants consider to be the invention for which a patent is being sought. The written description requirement requires that a subsequently patented invention be sufficiently disclosed at the time the application is filed, thereby preventing an application from subsequently claiming an invention that was not fully and clearly described as originally filed. As discussed in *In re Smith* (481 F.2d 910, 178 U.S.P.Q. 620 (CCPA 1973)), "Satisfaction of the description requirement insures that subject matter presented in the form of a claim subsequent to the

filing date of the application was sufficiently disclosed at the time of filing so that the *prima facie* date of invention can fairly be held to be the filing date of the application. (*Id.* at 914, 178 U.S.P.Q. at 623-624)

With a written description rejection, the Examiner bears the burden of providing the *prima facie* case to support the rejection of an application. As previously stated by the Board of Patent Appeals and Interferences, "The Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in [the] specification disclosure a description of the invention defined by the claims". (See *In re Moore*, 439 F.2d 1232, 1235, 169 U.S.P.Q. 236, 238 (CCPA 1971).) The Examiner has not proven a *prima facie* case of lack of written description.

In order to show a *prima facie* case of lack of written description, the following elements are required: (1) The application does not reasonably describe or convey the concepts; (2) to one of ordinary skill in the art; (3) at the time of filing the patent application; (4) that the inventor had possession of the claimed invention. Accordingly, the Examiner must show that each of the above elements is present in order for a rejection on the application based on the written description requirement to be proper. In order to overcome such a rejection, the Applicants need merely show that one or more of the elements is not present.

In the present case, the amended independent claims 1, 10, 16 and 21-22 each reasonably describe or convey the claimed concepts to one of ordinary skill in the art at the time the present patent application was filed. Accordingly, such description shows that the inventor had possession of the claimed invention. Referring to independent claim 10, a tracking apparatus has "processing circuitry...and memory...". Support for the processing circuitry of the tracking apparatus is provided at least at page 9, lines 10-15. Further support is provided where the processing circuitry is configured to monitor page count delivered as output by the image forming device at least at page 9, lines 29-31, and page 10, lines 1-5. Even further support is provided for hybrid push-pull data gathering of transaction detail at least at page 14, lines 6-24.

Hence, Applicants assert that amended claims 10-15 overcome the §112, first paragraph, rejection, and withdrawal of the rejection is respectfully requested.

**Rejections Under 35 U.S.C. §103**

Claims 1-3 and 5-9 are rejected under 35 U.S.C. §103(e) as being anticipated by *Maniwa* (U.S. Patent 5,933,584) and *Davidson, Jr., et al.* (U.S. Patent 6,025,925).

Claims 10-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of *Davidson, Jr., et al.* (U.S. Patent No. 6,025,925) and *Maniwa* (U.S. Patent No. 5,933,584).

With regard to claim 1, the Examiner has asserted that *Maniwa* teaches an apparatus for tracking usage information for an image forming device comprising an image forming device, processing circuitry associated with the image forming device, and computer program code implemented on the processing circuitry that is operative to count page-area and toner coverage at the image forming device collected on a print job-by-print job basis, and memory coupled with the processing circuitry and operative to store a data file containing the user information, the job output information, and the usage information comprising total page area and toner use. The Examiner also asserts that *Maniwa* teaches the tracking apparatus configured to implement data gathering of transaction details from the image forming device including consumable usage information. The Examiner then asserts that *Maniwa* does not teach the hybrid pull-push data that is implemented by the tracking apparatus for gathering of transaction details from the image forming device including consumable usage information. The Examiner then asserts that *Davidson, Jr., et al.* teaches such a tracking apparatus configured to implement hybrid pull-push data gathering of transaction details from the image forming device including consumable usage information. The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tracking apparatus of *Maniwa* to implement hybrid pull-push data gathering of transaction details from the image forming devices taught by *Davidson*. The Examiner asserts that the suggestion for

modifying the tracking apparatus of *Maniwa* could be reasoned by someone of ordinary skill in the art as set forth in *Davidson* because the modified pending system would be reliable by tracking the information on the consumable usage for each of the printers on the network.

Applicants disagree with the Examiner's assertion. First, *Maniwa* does not teach the computer program code provided in the same manner as Applicants' invention. More particularly, Figure 1 of *Maniwa* shows clearly that a print server machine 106 is discrete and separate from printers 112. In Figure 2, *Maniwa* shows that print server machine 106 is separate from individual printers 112.

As recited in claim 1, the computer program code is implemented on the processing circuitry of the tracking apparatus that is provided on the image forming device. As recited in the Background of the present application, inaccurate counting of paper usage results when counting is carried out at the wrong location using prior art systems. Instead, the best place to count hard copy pages is at the output side of a hard copy device (see page 3, lines 21-26). The tracking apparatus of the present invention collects specific information at the image forming device that describes toner coverage and paper use by the image forming device when generating individual pages and/or print jobs. This methodology involves trapping toner coverage and paper-used information at the image forming device in the form of data which allows the data to be collected where it can be evaluated and/or retrieved (see page 8, lines 23-29). *Maniwa* does not teach processing circuitry and memory that collects and traps such information at the image forming device. Instead, *Maniwa* teaches processing circuitry within a print server machine 106.

In order to establish a *prima facie* case of obviousness, the Examiner must provide: (1) One or more references; (2) that were available to the inventor; and (3) that teach (4) a suggestion to combine or modify the references; (5) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

Here the Examiner has failed to establish one or more references available to the inventor that teach the tracking apparatus that has the

processing circuitry, computer program code, and memory therein as provided on the image forming device.

The same argument is applied with regard to the limitations in newly amended independent claims 10, 16, and 21-22.

Hence, Applicants assert that amended claims 1-3 and 5-22 overcome the 35 U.S.C. §103 obviousness rejection, and withdrawal of the rejection is respectfully requested.

### CONCLUSION

For all the reasons advanced above, Applicants respectfully submit that the application is in condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview before issuance of any such subsequent action.

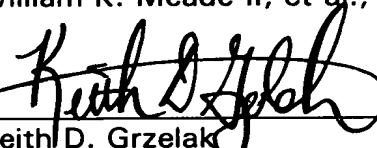
Respectfully submitted,

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9/16/04

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